UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,220	02/14/2001	Hideki Akiyama	24526	9695

20529	7590	03/27/2006

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EXAMINER
PHAM, THIERRY L

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 January 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 2* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

● This action is responsive to the following communication: an Amendment filed on 1/27/06.

● Claims 1-2 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art, and in view of Kurachi (U.S. 6181436).

Regarding claims 1-2, applicant admitted the prior art teaches a printer driver (fig. 1), provided at a host computer (host computer, page 2, lines 1-20) while said host computer is connected to a stencil printer (stencil printer, page 2, lines 1-20) printing machine through communications (communication between host computer and stencil printer, page 2, lines 1-20), for setting items of various conditions for said stencil printing machine, wherein the various setting items (setting items, page 2, lines 2-5) for said printing conditions are displayed (fig. 1); a watermark (watermark settings, fig. 1) print item is selected on the setting items; and information on the items are transmitted, together with the print data (watermark settings and print data are transmitted to stencil printer, page 2, lines 2-20), to the stencil printing machine (applicant admitted the prior art teaches a stencil printer having "secret operation settings button" as show in fig. 1, page 2, lines 1-20).

However, applicant's admitted prior art does not teach printer's features such as "secret operation settings" can be incorporated into the printer driver (which allows operator to control printer's features via from a host computer) and if the printer driver determines that a watermark print is selected on the setting items, the printer driver automatically selects secret operation item.

Kurachi, in the same field of endeavor for printer driver, teaches a printer driver (printer driver, col. 7, lines 59-60) having "secret operation settings" (secret operation settings, col. 5, lines 4-10, col. 13, lines 55-62, col. 17, lines 8-25, and col. 26, lines 35-46) can be incorporated into the printer driver and if the printer driver determines that a watermark print (watermark print is widely known and available in the art) is selected on the setting items, the printer driver automatically selects secret operation item (setting defaults for automatically selecting certain features/functions are well known and widely available in the art, for example, printer driver as taught by Kurcahi can be modified to automatically set secret operation settings upon selection of watermark settings).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify applicant's admitted prior art printer driver as per teachings of Kurachi by incorporating "secret operation features" onto printer driver because of a following reason and if the printer driver determines that a watermark print (watermark print is widely known and available in the art) is selected on the setting items, the printer driver automatically selects secret operation item: (●) to allow operators/users to control printer's capabilities/features of the printer remotely; therefore, reduces operating costs; (●) security/confidential of print data can be secured from intruders (Kurachi, col. 6, lines 29-30); (●) automatically defaults certain features/functions of printer driver helps reduce/prevent operators/users' errors.

Therefore, it would have been obvious to combine applicant's admitted prior art with Kurachi to obtain the invention as specified in claims 1-2.

Response to Arguments

Applicant's arguments filed 1/27/06 have been fully considered but they are not persuasive.

● Regarding claims 1-2, the applicant argued the cited prior art of record (US 6181436 to Kurachi) fails to teach and/or suggest a printer driver that can select a secret keeping operation for print data. Secret keeping as taught by Kurachi is for "print job information" rather than print data.

In response, the examiner fully disagrees with applicant's arguments/assertions. Kurachi teaches a printer driver which realizes a secret keeping operation for "print data", see col. 5, lines 4-10, col. 6, lines 29-30, col. 13, lines 55-62, col. 17, lines 3-12. For example, col. 6, lines 29-30, Kurachi states, "it is possible to keep the contents of this print data secret". On col. 13, lines 55-62, Kurachi explicitly teaches a secret setting information is selectable (e.g. switch box) and is displayable via display unit 15. The purpose of doing so is to keep print data secret not to be viewed by other people (col. 13, lines 55-62).

• Regarding claims 1-2, the applicant argued secret-keeping instructions sent by the printer driver of Kurachi could not initiate the secret-keeping operations to which the the Present Application is directed: "soon after the completion of printing, the used stencil sheet is removed form the print drum to make printing impossible and the removed stencil sheet is disposed of in a stencil disposal box".

In response, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., soon after the completion of printing, the *used stencil sheet* is removed form the print drum to make printing impossible and the removed stencil sheet is disposed of in a stencil disposal box) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

• Regarding claims 1-2, the applicant argued that the Examiner is improperly taking Official Notice that the prior art teaches "watermark print is widely known and available in the art" and "setting defaults for automatically selecting certain features/functions are well known and widely available in the art".

In response, the Examiner is herein attached references that teach these well-known features.

(1) An example of watermark print via printer driver is taught by applicant's admitted prior art (fig. 1).

(2) US 6301013 to Momose et al, teaches an example of watermark print via printer driver (figs. 6-11).

(3) US 6621590 to Livingston, teaches an example of watermark print via printer driver (figs. 3-5) with print default settings, for example, a default message such as "secret", shown in fig. 5 is incorporated into document 11 when a "print watermarks" box is checked (fig. 3a).

(4) US 5704021 to Smith et al, teaches an example of printer driver wherein certain features are defaulted based upon selected printing conditions (i.e. error-diffusion halftoning technique 22 is automatically selected whenever a high resolution mode is selected, col. 6, lines 15-22 and col. 9, lines 29-56).

In other words, it is well known in the art that related printing features could be modified and/or programmed so that it can be automatically selected if one of the desired printing features is selected. Therefore, it is well known to modify printer driver to automatically selects "secret operation" whenever a "watermark print" is checked or set as a default that "secret operation" is automatically selected when water print is checked/designated.

Applicant's arguments, see 2-3, filed 1/27/06, with respect to claim 2 have been fully considered and are persuasive. The 112, 2nd paragraph rejection of claim 2 has been withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the
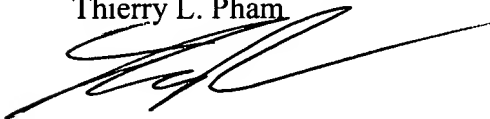
advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
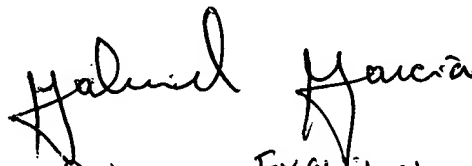
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

Primary Examiner
Gabriel Garcia